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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,489	03/11/1999	JAY S. WALKER	WD2-98-092	7106

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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/267,489

Applicant(s)

WALKER ET AL.

Examiner

James A. Reagan

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Status of Claims**

1. The claims currently pending before this office are numbers 1-12, 14-22, 24-35, and 38-50 as provided in amendment A (paper #10) filed on 11 February 2002, and numbers 13, 23, 36, and 37 as originally filed.
2. Claims 51-59 have been cancelled.
3. Claims 1-50 are reviewed in this Office action.

### **Specification**

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 1). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5-12, 14, 18-25, 27, 31-39, and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435).

**Claims 1, 27, and 39:**

Sending an automated verification email message to the mailing list member and receiving a response from the member (column 2, lines 10-19).

Selecting a mailing list from a plurality of mailing lists is inherent to the process of developing mailing lists according to a demographic, product, service, or other relevant subject (column 1, lines 14-15, column 3, lines 4-13 and lines 55-61).

Druckenmiller does not specifically disclose a postal mailing address. However, using a postal address as a correlation to an email address is an obvious choice relative to a demographic profile. In the specification, applicant states, "the subset of list members...can be selected with an eye toward various factors such as the demographics of the particular members, because the postal mailing lists are already compiled based on such factors." Druckenmiller, in column 7, lines 18-22 discloses, "demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements." It would have been obvious to one of ordinary skill in the art at the time of the invention to use the demographic of a postal mailing address as a selection device for identifying possible mail recipients. Using a postal mailing address geographically identifies a target audience, and is already a well known practice in the targeted marketing practices.

**Claim 14:**

The limitations of Claim 14 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis, with the following noted exceptions. Claim 14 recites a processor, database, communication port, and a memory. Druckenmiller discloses a computer and a database in Figure 1.

**Claims 5, 18, 31, and 43:**

An email message is sent to each member of the mailing list. The content of each email is individualized and differs from the others by the email address and token identifier tailored to each subscriber (column 3, lines 34-45 and Figure 3).

**Claims 6, 19, 32, and 44:**

Storing the data concerning the member, such as subscriber information from the subscription form (column 6, lines 42-50).

**Claims 7, 20, 33, and 45:**

Selected topics are imbedded into the email to determine the content of the mailing list the member is to be associated with (column 3, lines 55-61).

**Claims 8, 35, and 47:**

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

**Claims 9, 36, and 48:**

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

**Claims 10, 37, and 49:**

Mailing list selection based on the answers to the demographic/topic of interest questions (column 6, lines 34-42).

**Claims 11, 21, 34, 38, 46, and 50:**

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

**Claims 12:**

Response to the message is made through a URL (column 2, lines 16-19).

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**Claim 22:**

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

**Claim 23:**

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

**Claim 24:**

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

**Claim 25:**

Response to the message is made through a URL (column 2, lines 16-19).

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7. Claims 2-4, 15-17, 28-30, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of Applicant's own admission.

**Claims 2, 15, 28, and 40:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose selling the mailing lists. Applicant, however, on page 2, line 10 of the specification, discloses a business purchasing a mailing list, inherently disclosing that a mailing list is bought and sold as a marketable item. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then selling the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth.

**Claims: 3, 16, 29, and 41:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 2, lines 8-9 of the specification, discloses that a mailing list may be rented. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then renting the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's



customer/client base, thereby generating potential growth. Renting is an option to purchasing the list because the accuracy of the list may decrease after a period of time, driving the value of the list downward.

**Claims 4, 17, 30, and 42:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 1, line 29 to page 2, line 1 of the specification, discloses that a mailing list may be used to "mail promotional items such as brochures, advertisements, or sales offers to persons included in the list." It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then mailing items to members on the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual and groups who may be interested in involving themselves with the organization.

8. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of McEvoy et al., United States Patent Number 6,292,785, hereafter referred to as "McEvoy."

**Claims 13 and 26:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claim 1. Druckenmiller does not disclose compensating list members with an incentive. McEvoy, however, in column 5, lines 13-27, discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and compensating members who join the list because a reliable and accurate list of customer leads is a valuable asset, and enticing members with an incentive is a proven and effective way to increase participation, thereby increasing the value of the mailing list.

### **Response to Arguments**

9. Applicant's arguments filed on 08 February 2002 have been fully considered but they are not persuasive.
10. In Applicant's response to the first Office Action, Applicant indicated that the reference of Druckenmiller does not suggest that *a postal mailing list be selected from a plurality of postal mailing lists based on responses to e-mail messages sent to subsets of the postal mailing lists*. The Examiner cited relevant portions of the references as a means to illustrate the systems taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office Action, the Examiner has expanded the explanation of the teaching for clarity on the new grounds for rejection of the claims as applied

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above. Therefore, Applicant's arguments are now moot based on the new grounds of rejection.

However, with regard to claim 1, limitation (c), Applicant states that selection of a mailing list is based on the response to the e-mail messages. Examiner stated that it would be inherent to select a mailing list from a group of mailing lists. Not selecting a group of recipients from a set of responses would inherently halt the progression towards the goal of deriving a suitable mailing list for use or resale. In addition, it is also inherent to pick and choose among the responses based on the reply itself. A response that indicated an interest in dog food might be suitable for inclusion in a mailing list tailored for dog toys, but might not be suitable for a mailing list intended for purchasers of home computing products. Inherently, fundamental rules and guidelines regarding the inclusion or exclusion of a recipient in a mailing list is an integral part of the selection and compilation process.

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tariq Hafiz** can be reached on **(703) 305-9643**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

**Washington, D.C. 20231**

or faxed to:

**(703) 746-7238** [After Final communications, labeled "Box AF"]


**(703) 746-7239** [Official communications]

**(703) 746-8144** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA, Fourth Floor Receptionist.

JAR

15 April 2002

  
KYLE J. CHOI  
PRIMARY EXAMINER  
*Art Unit 3623*